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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,903	03/13/2002	Tatsuo Yoshioka	83394.0001	3624
26021	7590	09/12/2006	EXAMINER	
HOGAN & HARTSON L.L.P. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067			GOTTSCALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,903

Applicant(s)

YOSHIOKA ET AL.

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/13/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Claims 1-23 have been examined.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

- A. In the present case, the abstract is slightly too long.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-8, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitcham (US Pat# 5,537,315, hereinafter Mitcham).

A. As per independent claim 1, Mitcham discloses an automobile insurance contents setting system that is configured to:

request an insurant to submit his/her driving behavior, based upon an application for automobile insurance for which the insurant has specified coverage and indemnity (Mitcham: col 4, Ins 13-14; col 5, Ins 1-36, behavior reads on "...how the car is driven..."; col 5, Ins 58-65, "levels of coverage" read on by coverage and indemnity, see also Fig 3E, item 244; Figs 5, 6, 7, 8, 9, 10; col 7, Ins 55-58, behavior reads on "...driving history, claims history...");

evaluate the driving behavior submitted by the insurant (Mitcham: col 8, Ins 1-23; Fig 3G, item 302);

and

calculate a premium of the automobile insurance in accordance with the evaluated driving behavior of the insurant (Mitcham: col 4, Ins 14-18; col 8, Ins 10-14; Fig 3G, item 312).

B. As per independent claim 2, it comprises substantially the same features disclosed by Mitcham in the rejection of claim 1 above, with the additional steps disclosed by Mitcham of:

submitting the calculated premium to the insurant (Mitcham: col 6, lns 20-24; col 8, lns 37-47, i.e. "print quote");

charging the premium in the insurant database to the insurant, based upon the application for automobile insurance (Mitcham: col 6, ln 61 to col 7, ln 42);

and

entering a conclusion of a contract of the automobile insurance into the insurant database based upon payment of the premium by the insurant (Mitcham: col 6, lns 25- 34; col 8, ln 62 to col 9, ln 9; Fig 14).

C. As per dependent claims 3-6, Mitcham discloses an automobile insurance contents setting system according to claim 1, wherein the driving behavior of the insurant to be submitted by the insurant includes

(claim 3) a driving history of the insurant (Mitcham: col 7, lns 55-58).

(claim 4) a traffic violation record of the insurant (Mitcham: col 5, 23-26; Fig 7).

(claim 5) a traffic accident record of the insurant (Mitcham: col 5, 27-29; Fig 8).

(claim 6) a total distance driven by the insurant (Mitcham: col 5, lns 32-36; Fig 10, item 1002, reads on "TO/FROM WORK").

D. As per independent claim 7, it recites substantially the same features of claim 1 and is rejected for the same reasons with the exception that "driving behavior" in claim 1 is changed to "driving condition" in claim 7. Mitcham discloses this feature as well:

request an insurant to submit his/her driving condition (Mitcham: col 5, lns 32-36, reads on "...how the car is driven..."),

E. As per independent claim 8, it recites substantially the same features of claim 2 and is rejected for the same reasons with the exception that "driving behavior" in claim 2 is changed to "driving condition" in claim 8. Mitcham discloses this feature as well:

F. As per dependent claims 13 and 14, Mitcham discloses an automobile insurance contents setting system according to claim 7, wherein the driving condition of the insurant to be submitted by the insurant includes

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(claim 13) an area in which the insurant principally drives an automobile.

(claim 14) a dedicated use of an automobile to commutation to and from work (for both claims, see Mitcham: col 5, lns 32-36; Fig 10, item 1002, reads on "TO/FROM WORK").

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 9-11 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitcham in view of McMillan et al (US Pat# 5,797,134, hereinafter McMillan).

A. As per claims dependent 9-11, Mitcham fails to explicitly disclose these features, however, they are well known in the art as evidenced by the teachings of McMillan who discloses

an automobile insurance contents setting system according to claim 7, wherein the driving condition of the insurant to be submitted by the insurant includes

(claim 9) a limited time of day to the night hours during which the insurant drives an automobile (McMillan: col 6, ln 38, item "C").

(claim 10) a level of maintenance conditions of an automobile of the insurant (McMillan: col 9, 38-42, the Examiner considers sensing of tire pressure to be a type of level of maintenance.).

(claim 11) the number of occurrences of engine trouble of an automobile of the insurant (McMillan: col 9, 38-42, the Examiner notes that engine trouble is a condition requiring roadside assistance which would be sensed and documented by the system.).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of McMillan with those of Mitcham with the motivation of basing insurance charges on actual driving characteristics of a particular

vehicle and a particular driver's driving behavior, thus allowing frequent adjustments to the insured's premium based on these characteristics, which would further allow insurance premium charges to be under greater control of the individual consumer/driver (McMillan col 3, lns 47-57).

Note: In the claim rejections which follow combining the teachings of Mitcham and McMillan, the same motivation to combine the teachings as provided above for claims 9-11 apply and will not be repeated.

B. As per claim independent 15, Mitcham discloses an automobile insurance premium setting system that is configured to:

calculate a basic premium, based upon an application for automobile insurance for which an insurant has specified coverage and indemnity, the basic premium being invariably determined in accordance with the indemnity of the automobile insurance (Mitcham: col 4, lns 14-18; col 8, lns 10-14; Fig 3G, item 312);

request the insurant to submit his/her driving behavior (Mitcham: col 4, lns 13-14; col 5, lns 1-36, behavior reads on "...how the car is driven..."; col 5, lns 58-65, "levels of coverage" read on by coverage and indemnity, see also Fig 3E, item 244; Figs 5, 6, 7, 8, 9, 10; col 7, lns 55-58, behavior reads on "...driving history, claims history...");

Mitcham fails to explicitly disclose the remaining features of the claim, however, these features are well known in the art as evidenced by the teachings of McMillan who discloses

estimate an additional premium based upon the driving behavior submitted by the insurant;

provisionally collect a premium payable calculated by adding the basic premium and the additional premium (for both features, see McMillan: col 4, Ins 7-12; col 10, Ins 8-44);

determine driving behavior points and safe driving points, the driving behavior points being counted each time when actual driving behavior of the insurant deviates from criteria determined based upon the driving behavior submitted by the insurant, and the safe driving points being counted each time when the actual driving behavior of the insurant deviates from safe driving criteria submitted to the insurant in advance;

and

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combine the driving behavior points and the safe driving points into demerit points to calculate an actual additional premium corresponding to the demerit points, and balance a difference between the estimated additional premium and the actual additional premium upon expiration of the automobile insurance (for the last two features, see McMillan: col 4, ln 60 to col 5, ln 9; col 10, lns 24-44).

C. As per independent claim 16, Mitcham discloses an automobile insurance premium setting system that is configured to perform the steps of:

entering insurance contents into an insurant database, based upon an application for automobile insurance for which an insurant has specified coverage and indemnity by selecting among coverages and indemnities stored in an automobile insurance contents database (Mitcham: col 4, lns 13-17; col 5; col 5, lns 58-65, "levels of coverage" read on by coverage and indemnity, see also Fig 3E, item 244; Figs 5, 6, 7, 8, 9, 10; col 7, lns 55-58);

The remaining features substantially recite the features of claim 15 and are thus rejected for the same reasons provided above for claim 15.

D. As per independent claims 17, 21, 22, 23 they are rejected for the same reasons provided above for claim 15.

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E. As per independent claim 18, it is rejected for the same reasons provided above for claim 16.

F. As per claim 19, Mitcham fails to disclose the features of this claim, however, these features are well known in the art as evidenced by the teachings of McMillan who discloses

an automobile insurance premium setting system according to claim 15, wherein the driving behavior points concern

speeding (McMillan: col 9, lns 58-60, item "1."),

abrupt braking (McMillan: col 10, lns 3-4),

abrupt steering (McMillan: e.g. col 8, ln 2, "skid"; ln 11, "lateral acceleration"; ln 12, "sudden rotation of vehicle"),

abrupt acceleration (McMillan: col 8, ln 1, "rapid acceleration"),

and

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zigzagging abrupt steering (McMillan: e.g. col 8, ln 2, "skid"; ln 11, "lateral acceleration"; ln 12, "sudden rotation of vehicle").

G. As per claim 20, Mitcham discloses an automobile insurance premium setting system according to claim 15, wherein the safe driving points concern

traffic accidents (Mitcham: col 5, 27-29; Fig 8),

traffic violations (Mitcham: col 5, 23-26; Fig 7),

and

neglecting periodical automobile inspections (Mitcham: col 7, ln 55-61, the Examiner notes that a department of motor vehicles report would include overdue inspections).

Mitcham fails to explicitly disclose the remaining features of the claim, however, these features are well known in the art as evidenced by the teachings of McMillan who discloses

long-sustained driving (McMillan: col 9, lns 60-61).

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8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malin et al (US PG Pub# 2002/0007289, hereinafter Malin).

A. As per claims dependent 12, Mitcham fails to explicitly disclose these features, however, they are well known in the art as evidenced by the teachings of Malin who discloses an automobile insurance contents setting system according to claim 7, wherein the driving condition of the insurant to be submitted by the insurant includes

the number of repairs of an automobile of the insurant (Malin: [0037]; Fig 2, item 275; [0044], note the "historical repair data record" database and its being in communication with other insurance-related entities).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Malin with those of Mitcham with the motivation of improving customer satisfaction with the overall insurance process thus avoiding the costs of re-acquiring dissatisfied customers (Malin: [0008]-[0011]).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art discloses systems for automatically processing requests for insurance policy quotes.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG
09/01/2006

Carolyn Bleck
Patent Examiner
9/5/06